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09/216,206	12/18/1998	DAVID WILLIAM ROTH	B2745.0025/P0025	1079
7590 10/13/2011 BEH INVESTMENTS LLC 1652 48TH STREET BROOKLYN, NY 11204				
EXAMINER				
VAN BRAMER, JOHN W				
ART UNIT		PAPER NUMBER		
3622				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/216,206

**Applicant(s)**

ROTH ET AL.

**Examiner**

JOHN VAN BRAMER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 49, 50, 62-96, 112-148, 164-200, 216-227, 231-269, 271 and 272 is/are pending in the application.
- 5a) Of the above claim(s) 271 and 272 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 49, 50, 62-96, 112-148, 164-200, 216-227, and 231-269 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. The applicant hereby grants priority for this application to application number 08/787,979 filed on January 22, 1997. This application has a continuation-in-part status and as such receives the January 22, 1997 priority date for only those disclosures that were already presented in the 08/787,979 application. .

### ***Specification***

2. The substitute specifications filed January 22, 2004 and March 5, 2007 are hereby entered.

### ***Response to Amendment***

3. The amendment filed on June 22, 2011 cancelled no claims. No claims were amended and no new claims were added. Thus the currently pending claims in the application are claims 49, 50, 62-96, 112-148, 164-200, 216-227, 231-269, 271, and 272 of which claims 271 and 272 have been withdrawn based upon restriction by original presentation. Thus the currently pending claims addressed below are claims 49, 50, 62-96, 112-148, 164-200 and 216-227, 231-269.

### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 49,50, 62-66, 114-118, 166-170, 218, 219, 226, 227, 231, 232-237 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claim 49: Goldhaber discloses a computerized method for determining an advertisement in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer system an indication of the advertising opportunity. (Col 7, lines 27-47)
- b. In response to receiving the indication: selecting in the computer system the advertisement from among a plurality of advertisements associated with bids submitted in real-time by the computer system on behalf of advertisers desiring to fulfill the advertising opportunity wherein the computer system is embodied with computer instructions for implementing the computerized method. (Col 4,

lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46 and Col 14, line 59 through Col 15, line 12)

Claim 50: Goldhaber discloses the method of claim 49, wherein the indication of the advertising opportunity is initiated by the browser sending a reference in the web page. (Col 14, line 59 through Col 15, line 6)

Claim 218: Goldhaber discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid being associated with indicating a monetary amount the each bidding advertiser is willing to pay if an advertisement associated with each bidding advertiser is selected and a specific event occurs. (Col 4, lines 47-63; and Col 14, lines 12-46; and Col 17, lines 33-63)

Claims 62: Goldhaber discloses a method implemented in a computer system, comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality

of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

- b. Receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- d. Selecting in the computer system a bid from among the submitted bids. (Col 4, lines 47-63)
- e. Identifying in the computer system an advertisement associated with the selected bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

- f. Serving with the computer system the identified advertisement in real time response to the request for the content, wherein the computer system is embodied with computer instructions for implementing the method. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim 114. Goldhaber discloses a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, wherein the each advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system comprising one or more networked computers, the one or more networked computers embodied with computer instruction that:
  - i. Maintains the plurality of advertisements and a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

- ii. Receives an indication of the request for content, thereby presenting the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- iii. Submits in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- iv. Selects a bid from among the submitted bids. (Col 4, lines 47-63)
- v. Identifies an advertisement associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- vi. Serves the identified advertisement in real time response to the request for content. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)



Claims 226 and 227: Goldhaber discloses the method of claims 62 and 114 respectively, wherein information about a viewer utilizing the browser is stored in the computer system. (Col 12, lines 14-37; Col 13, line 49 through Col 14, line 46; Col 15, lines 17-47; and Col 15, line 57 through Col 16, line 40)

Claims 166 and 233. Goldhaber discloses a method and system implemented in a computer system comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser, the method comprising:

- a. Receiving in the computer system an indication of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- b. In real time response to the indication: determining in the computer system one or more bids, each determined bid being associated with a monetary amount an advertiser associated with the each determined bid is willing to pay for the each determined bid is willing to pay for the each determined bid to be selected and a specific event to occur. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- c. Selecting in the computer system a bid from among the determined bids. (Col 4, lines 47-63)

- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process, wherein the computer system is embodied with computer instructions for implementing the method. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 63, 115, 167, 234: Goldhaber discloses the method of claims 62, 114, 166, 233 respectively, wherein the monetary amount associated with each of the submitted bids is included in the each of the submitted bids. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 64, 116, 168, 235: Goldhaber discloses the method of claims 62, 114, 166, 233 respectively, wherein the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

Claim 65, 117, 169, 219, 236: Goldhaber discloses the method of claims 62, 114, 166, 218, 233, wherein the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 66, 118, 170, 237: Goldhaber discloses the method of claims 65, 117, 169, 236 respectively, wherein the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 231 and 232: Goldhaber discloses the method and system of claims 62 and 114 respectively, wherein at least one of the plurality of sets of bidding parameters includes a plurality of levels, wherein a first level includes a first criteria of advertising opportunity and a second level includes the first criteria of advertising opportunities and a second criteria of advertising opportunities. (Col 4, lines 47-63; Col 7, lines 27-

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47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 67-96, 112, 113, 119-148, 164, 165, 171-200, 216, 217 and 220-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183: Goldhaber discloses the method of claims 62, 63, 64, 65, 66, 114, 115, 116, 117, 118, 166, 167, 168, 169, 170 respectively. Goldhaber further discloses the user logging onto a homepage and seeing ads that she may elect to view. (Col 7, lines 27-47). Goldhaber is silent with regard to the protocol used in transmitting the request from the browser, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the standard HTTP protocol for communicating between the website and the browser as well as provide

indications using said protocol. The rationale for using the standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers is that the HTTP protocol is one of a limited number or predictable protocols used to transmit requests from browsers.

Claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184: Goldhaber discloses the method of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, and 185: Goldhaber discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184 respectively, wherein the request for content by the browser is caused by a reference in the web page. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 82-96, 134-148, 186-200, 220, and 222: Goldhaber discloses the method of claims 67-81, 119-133, 171-185, 218, and 219 respectively, wherein the selection of

the selected bid is based on the selected bid being associated with an auction process. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63) While Goldhaber does not explicitly state the winning bid is associated with highest monetary amount, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the highest bid for the given targeting parameters as the winning bid in the auction process. The rationale for selecting the highest bid, is that there are a limited number of predictable processes used to select the winner of an auction process and one such predictable process is the selection of the highest bidder as the winner.

Claims 221 and 223: Goldhaber discloses the method of claims 218 and 219 respectively, wherein the selection of the selected bid is based on the selected bid being determined in a computer system through an auction process and including advertisement relevance or targeting criteria (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63). While Goldhaber does not explicitly state the winning bid is associated with highest beneficial value over respective beneficial values of other submitted bids, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the highest beneficial for the given targeting parameters as the winning bid in the auction process. The rationale for selecting the highest beneficial value, is that there are a limited number of predictable processes used to select the winner of an

auction process and one such predictable process is the selection of the bid that has the highest beneficial value.

Claims 112, 164, 216, and 224: Goldhaber discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid is associated with a respective bidding agent. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim 113, 165, 217 and 225: Goldhaber discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

### ***Response to Arguments***

8. Applicant's arguments filed June 22, 2011 have been fully considered but they are not persuasive.

a. The applicant argues that Goldhaber does not provide for a real time bidding and selecting mechanism, whereby the winning bid is selected by the system in real time. However, Goldhaber specifically discloses in Col 4, lines 47-63, that the system may offer bidding without the viewer's knowledge and that an

an auction protocol is used to accept bids and determine the winning bid and as such the advertisement is displayed to the viewer. The applicant appears to be reading limitations into the claims that are not currently present. The claims require that bids are submitted in real-time, but does not require that the selecting is occurring in real time. As such the limitations of the claims as currently written have been met. However, the examiner would like to point out that even if the bidding and selecting were both required to occur in real-time, the Goldhaber reference discloses such interaction. It is important to note that Goldhaber discloses in the abstract and Col 4, lines 47-63 that an auction process can be implemented without the interaction of the user itself. When this occurs it is disclosed in Col 4, lines 47-63 that the auction is done by "agents". Thus one must consider the disclosure of "agents" in the teachings of Goldhaber. According to Goldhaber in Col 9, lines 53-67, software agents comprise software processes nominally executing on behalf of Consumers, and that servers may act as attention brokers or trading houses and supply software agent with advertisements or other information to be viewed or reviewed by consumers. Goldhaber discloses in Col 14, lines 41-56 that the function of a software agent is to screen or filter ads against a consumer interest profile. While Goldhaber discloses in Col 14, lines 59-67 that the interest agent performs the auction process when the user is offline and presents the ads when the user next logs in, Goldhaber also discloses in Col 15, lines 1-12 that a user initiates a search request in real time through their agent, and that salesman agents working on



behalf of ads will actively search out opportunities and interact with your personal agent before serving the ad. Since the personal agent is discloses as performing auctioning function in Col 4, lines 47-63 it is clear that real time bidding and selecting is occurring. Finally, Goldhaber discloses the use of agents in performing an automated trading house for information exchange such as advertisements in Col 19 lines 19 through Col 20, line 55. Goldhaber discloses in this section that selling agents and buying agents negotiate in real time and, depending on the authorizations provided to each agent, the ability to consummate a transaction without user interaction. Thus it is clear that Goldhaber discloses the claimed real-time bidding.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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John Van Bramer

/John Van Bramer/

Primary Examiner, Art Unit 3622